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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,945	07/10/2001	Toshitada Saito	211200US2	7956
22850	7590	12/20/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.			TRIMMINGS, JOHN P	
1940 DUKE STREET			ART UNIT	
ALEXANDRIA, VA 22314			PAPER NUMBER	
			2138	

DATE MAILED: 12/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/900,945

Applicant(s)

SAITO, TOSHITADA

Examiner

John P. Trimmings

Art Unit

2138

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-12 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 08 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This office action is in response to the applicant's request for reconsideration dated 11/16/2005.

The applicant has not amended any claims.

Claims 1-12 are pending.

Response to Arguments

1. The applicant has submitted three paragraphs of arguments on page 3 of the Remarks/Arguments, in regard to the examiner's rejection under 35 USC 130 of Claim 1. The following is the examiner's rebuttal:

As per the 1st paragraph:

The applicant states that the AA does not teach or suggest "selection means for selecting one output". The examiner agrees, and the examiner had stated such a deficiency of the AA in the last office action because there are two outputs. However, the examiner did not rely on the AA, and instead referred to Higashida for this teaching.

As per the 2nd paragraph:

Where the applicant states that Higashida does not teach the selection means for selecting any one of the debug operations, the examiner disagrees. The circuit of FIG. 8 8c is shown selecting one of the inputs, with trace information being one of the inputs. Referring to FIG. 2 of Higashida, the trace information is further defined as being any

one of the debug signals. The applicant also states that "one output terminal" for monitor results is not taught, but the examiner reiterates that selected results from FIG.8 8A is a single output designated as the 8 bit output of the selector 8b.

Also argued is that Higashida does not teach "only one terminal" for outputting the result signal selected by the selector. In response to applicant's argument that the reference Higashida fails to show this feature of the applicant's invention, it is noted that the features upon which applicant relies (i.e., only one terminal for outputting the result signal) is not recited in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Therefore, the examiner maintains the rejection of these limitations as outlined in the previous office action under Higashida, and consequently, the rejection of Claim 1 is maintained.

As per the 3rd paragraph:

The applicant argues that Ogino fails to further support or disclose the same limitations that the applicant has contended are lacking in the 2nd paragraph above. But the examiner maintains (above) that the reference Higashida does indeed teach the argued limitations of the 2nd paragraph, and so the applicant's argument for Ogino is moot, in view of the limitations being maintained as per the 2nd paragraph above.

2. All other dependent claims were cited by the applicant as being dependent on Claim 1 and thus allowable. But since the examiner maintains the rejection of Claim 1, all dependent Claims 2-12 are also maintained as rejected.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Trimmings whose telephone number is (571) 272-3830. The examiner can normally be reached on Monday through Thursday, 7:30 AM to 6:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert DeCady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P Trimmings
Examiner
Art Unit 2138

jpt



GUY LAMARRE
PRIMARY EXAMINER